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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,513

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Ralf Dunkel

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7590

06/10/2009

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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/530,513	Applicant(s) DUNKEL ET AL.	
	Examiner Laura L. Stockton	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 9, 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-25, 27 and 30-33 is/are rejected.
- 7) ☒ Claim(s) 26, 28 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 18-33 are pending in the application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 9, 2009 has been entered.

Response to Amendment

The Declaration under 37 CFR 1.132 filed June 16, 2008 is sufficient to overcome the rejections of the claims based upon 35 USC §103 over Elbe et al.

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{CA 2,474,902}, taken alone, or in combination with Kanji et al. {JP 08/176112} and obviousness-type double patenting over application 10/502,994 (matured as U.S. Pat. 7,388,097).

The Declaration under 37 CFR 1.132 filed February 23, 2007 is insufficient to overcome the rejection of claims 18-25, 27 and 29-33 based upon 35 USC §103 over Walter et al. {WO 02/059086}, taken alone, or in combination with Kanji et al. {JP 08/176112} as set forth in the last Office action because the showing is not commensurate in scope with the instant claims. In re Greenfield, 197 U.S.P.Q. 227 (1978) and In re Lindner, 173 U.S.P.Q. 356 (1972). Also see M.P.E.P. 716.02(d).

For instance, instant Example 1 (page 39), Examples 8 and 9 (page 41), etc. should also have been compared in the comparison study against compounds such as

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Compound No. 4.20 (page 32), Compound Nos. 4.43 and 4.44 (page 33) in Walter et al.

Response to Arguments

Applicant's arguments filed March 9, 2009 concerning the example numbers in the Declaration under 37 CFR 1.132 filed February 23, 2007 are acknowledged and accepted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-25, 27 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walter et al. {WO 02/059086}, taken alone, or in combination with

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Kanji et al. {JP 08/176112}. A partial translation of the JP document was provided with a previous Office Action and will be referred to hereinafter.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicant claims thiazole compounds. **Walter et al.** {see entire document; particularly pages 1, 2 and 8-16; and especially Compound Nos. 4.19 and 4.20 (page 32), Compound Nos. 4.43 and 4.44 (page 33); and Compound No. 7.03 (page 39)} teach thiazole compounds which are structurally similar to the instant claimed compounds.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the compounds of Walter et al. and the compounds instantly claimed is that the instant claimed compounds are generically described in Walter et al.

Further, **Kanji et al.** teach the interchangeability of the various substituents attached to the nitrogen of the carboxanilide group (see the definition of R1 in

Kanji et al. in paragraph [0009]) in thiazole compounds that are useful as microbicidal agents.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The indiscriminate selection of "some" among "many" is *prima facie* obvious, In re Lemin, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., controlling undesired microorganisms).

One skilled in the art would thus be motivated to prepare products embraced by Walter et al., especially in view of the teachings in Kanji et al., to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful for controlling undesired microorganisms. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

Response to Arguments

All of Applicant's arguments filed March 9, 2009 have been fully considered. Applicant continues to argue the rejection of the claims over Walter et al. {WO 02/059086}, taken alone, or in combination with Kanji et al. {JP 08/176112}. However, absent a persuasive side-by-side factual showing of unexpected, unobvious and beneficial results of the instant claimed compounds over the closest prior art compounds, commensurate in scope therewith, the instant claimed compounds would have been suggested to one of ordinary skill in the art and therefore, the instant claimed compounds would have been obvious to one of ordinary skill in the art. The rejection is deemed proper and therefore, maintained for all the reasons of record in previous Office Actions.

Allowable Subject Matter

Claims 26, 28 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

/Laura L. Stockton/
Laura L. Stockton
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

June 11, 2009